

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MISSOURI  
EASTERN DIVISION

DEKALB GENETICS CORP.,	)	
	)	
Plaintiff(s),	)	
	)	
vs.	)	Case No. 4:06CV01191-ERW
	)	
SYNGENTA SEEDS INC. et al.,	)	
	)	
Defendant(s).	)	

**MEMORANDUM AND ORDER**

This matter comes before the Court on Defendant's Motion to Compel Production of Documents [doc. #63].

**I. BACKGROUND**

Plaintiff filed suit against Defendants for patent infringement on August 9, 2006. In accordance with the Case Management Order entered on January 26, 2007, the parties are currently pursuing discovery. Defendants requested the production of documents. Plaintiff responded to this request by producing a number of documents as well as providing a privilege log as the basis for failing to produce a number of additional documents. Plaintiff has supplemented its privilege log on a number of occasions, each time producing additional documents to the Defendants. Despite these supplements, Defendants still assert that the privilege log is inadequate and that the documents listed are discoverable. The Court held a hearing on this matter on May 16, 2007, and ordered that the documents in question be produced to the Court for *in camera* review.

**II. STANDARD OF REVIEW**

The Federal Rules of Civil Procedure allow a party to “obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party. . .” Fed. R. Civ. P.

26(1). The Federal Rules further provide for the protection of trial preparation materials;

a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party’s representative . . . *only* upon a showing that the party seeking discovery has substantial need of the materials in the preparation of the party’s case and that the party is unable without undue hardship to obtain the substantial equivalent of the materials by other means.

Fed. R. Civ. P. 26(b)(3). These rules allow for the protection of materials under two distinct sets of rules, the first protects communications between an attorney and his client, the second protects information or material assembled in anticipation of litigation. *Diversified Industries, Inc. v. Meredith*, 572 F.2d 596, 601 (8th Cir. 1977).

When a party withholds documents or materials under a claim of privilege, the rules place the burden on the party asserting the privilege to prove its applicability. Fed. R. Civ. P. 26(b)(5); *United States v. Evans*, 113 F.3d 1457, 1461 (7th Cir. 1997) (“The party seeking to invoke the privilege bears the burden of proving all of its essential elements.”); *see also* 8 CHARLES ALAN WRIGHT, ARTHUR R. MILLER & RICHARD L. MARCUS, FEDERAL PRACTICE AND PROCEDURE, Civil 2d § 2016.1 (2d ed. 1994) (“As a starting point, it is clear that ultimately a party asserting privilege must make a showing to justify withholding materials if that is challenged.”).

Specifically, the Federal Rules require that

[w]hen a party withholds information otherwise discoverable under these rules by claiming that it is privileged or subject to protection as trial-preparation material, the party shall make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the applicability of the privilege or protection.

Fed. R. Civ. P. 26(b)(5).

The Eighth Circuit provides a concise definition of Attorney-client privilege: “where legal advice of any kind is sought from a professional legal advisor in his capacity as such, the communications relevant to that purpose, made in confidence by the client, are at his instance permanently protected from disclosure by himself or by the legal advisor except the protection be waived.” *Diversified*, 572 F.3d at 602. The Eighth Circuit further cautions that due to the absolute nature of the privilege, and its adverse effect on the disclosure of truth, the privilege is strictly construed. *Id.* The Eighth Circuit also provides a definition of the work product doctrine, as protecting those materials “obtained in anticipation of litigation or for trial.” *Id.* at 603. The Eighth Circuit recognizes that “the qualified immunity or privilege accorded to work product by the rule is to some extent broader than the absolute attorney-client privilege that has been discussed[,]” as it “is not confined to information or materials gathered or assembled by a lawyer.” *Id.*

### **III. DISCUSSION**

The Court has reviewed the Documents and the following order lists which documents must be produced, which documents are protected by privilege, and which documents require further explanation by Plaintiff. Due to the large number of documents, the Court will list each document number, as listed in Plaintiff’s Fourth Amended Privileged Document Log, the asserted privilege, and whether such document must be disclosed. In reaching its decisions the Court is mindful that the burden is on the Plaintiff to show that the privilege is applicable, and therefore where the Plaintiff has failed to provide sufficient explanation of its claim of privilege, the documents are ordered produced, unless additional evidence is provided to the Court’s satisfaction.

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0001	Attorney-Client/ Work Product	09/08/1988	Lab Notebook	Privileged (Attorney-Client)
0002	Attorney-Client/ Work Product	10/20/1988	Lab Notebook	Privileged (Attorney-Client)
0003	Attorney-Client/ Work Product	9/21/1988	Lab Notebook	Pages 1-4 not privileged- Produce. Page 5 not privileged- produce. However, the Plaintiff may provide additional information regarding who page five was prepared for, who signed "read and understood" so the Court can determine whether it is privileged.
0005	Attorney-Client/ Work Product	10/17/1997	Correspondence	Privileged (Attorney-Client)
0011	Attorney-Client	02/14/1995	Correspondence	Privileged
0013	Attorney-Client	None	Presentation	Not Privileged-Produce The Court can find no evidence of an attorney who was involved in producing this presentation. Therefore, the information must be produced.
0021	Attorney-Client	11/05/1998	Form	Privileged
0022	Attorney-Client	11/06/1998	Form	Privileged
0034	Attorney-Client	11/30/1998	Form	Privileged
0035	Attorney-Client	1999	Publication	Privileged
0037	Attorney-Client	09/27/1999	Form	Privileged
0039	Attorney-Client/ Work Product	01/25/1983	Lab Notebook	Privileged (Attorney-Client)
0040	Attorney-Client/ Work Product	05/30/1989	Lab Notebook	Privileged (Work Product)

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0041	Attorney-Client/ Work Product	02/28/1989	Lab Notebook	Privileged (Work Product)
0042	Attorney-Client	06/11/1997	Correspondence	Privileged
0044	Attorney-Client	09/01/1999	Correspondence	Privileged
0045	Attorney-Client	08/11/1999	E-mail w/ attachment	Privileged
0046	Attorney-Client	06/18/1999	Correspondence	Privileged
0047	Attorney-Client	04/21/1997	Correspondence	Privileged
0055	Attorney-Client	12/01/1995	Correspondence	Privileged
0056	Attorney-Client	05/26/1994	Correspondence	Privileged
0059	Attorney-Client	05/04/1995	Correspondence	Privileged
0060	Attorney-Client	05/26/1994	Correspondence	Privileged
0061	Attorney-Client	04/06/1995	Correspondence	Privileged
0062	Attorney-Client	05/26/1994	Correspondence	Privileged
0065	Attorney-Client	10/12/1994	Correspondence	Privileged
0066	Attorney-Client	05/26/1994	Correspondence	Privileged
0068	Attorney-Client	07/20/1994	Correspondence	Privileged
0069	Attorney-Client	08/28/1996	Correspondence	Privileged
0070	Attorney-Client	09/16/2002	Correspondence	Privileged
0072	Attorney-Client	02/03/2000	Correspondence	Privileged
0076	Attorney-Client	09/15/1999	Correspondence	Privileged
0077	Attorney-Client	09/01/1999	Correspondence	Privileged
0078	Attorney-Client	04/21/1997	Correspondence	Privileged
0082	Attorney-Client	12/17/1998	Correspondence	Privileged
0085	Attorney-Client	08/21/1998	Correspondence	Privileged
0094	Attorney-Client	02/19/1998	Correspondence	Privileged
0095	Attorney-Client	11/09/1989	Report	Not Privileged-Produce

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0096	Attorney-Client	02/1990	Report	Not Privileged-Produce
0097	Attorney-Client	09/05/1990	Report	Not Privileged- Produce
0098	Attorney-Client	07/1990- 09/1990	Report	Not Privileged-Produce

The redacted portions in documents 0095-0098 contain information regarding the prosecution of certain patent applications, which Plaintiff asserts is protected by the attorney-client privilege. Plaintiff is correct that an attorney's advice regarding a patent application is protected by the privilege. *Ryobi North America, Inc. v. Union Elec. Co., Inc.*, 7 F.Supp.2d 1019, 1021-22 (E.D. Mo. 1998) (“[I]nventors and their patent counsel often engage in quite substantive private dialogue as part of the process of shaping and focusing a patent application and like any other attorney-client relationship it is reasonable for them to expect their dialogue to remain confidential.”). However, Plaintiff has failed to show how the redacted portions reflect legal advice in this case, and have failed to identify how the redacted portions represent dialogue between an attorney and his client. Plaintiff emphasizes that the documents were located in Monsanto/Dekalb's legal files, however, this alone is not sufficient to apply the attorney-client privilege. The case relied upon by Plaintiff allows for the application of attorney-client privilege without a named author or recipient when the document reflected legal advice, communicated to the party by outside counsel's law firm. *Tulip computers Intern, B.V. v. Dell Computer Corp.*, 2002 WL 31556498, \*1 (D.Del. Nov. 18, 2002). The documents before this Court do not contain clear legal advice, but merely reference a patent application. Nor is there evidence that the documents were prepared by outside counsel's firm. Therefore documents 0095-0098 must be produced, unless Plaintiff can provide further information satisfactorily establishing privilege.

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0099	Attorney-Client	07/1990- 09/1990	Report	Privileged
0100	Attorney-Client	10/03/1990	Report	Privileged
0101	Attorney-Client	01/07/1991	Report	Privileged
0103	Attorney-Client/ Work Product	2/13/2002- 03/07/2002	E-mails	Privileged
0104	Attorney-Client/ Work Product	02/19/2002	E-Mail	Privileged
0105	Attorney-Client	09/20/1989	Correspondence	Not privileged-Produce. There is no evidence that the communication pertains to legal advice, and furthermore the author is not listed as an employee of Plaintiff corporation.
0106	Attorney-Client	09/18/1989	Correspondence	Not privileged-Produce. There is no evidence that the communication pertains to legal advice, and furthermore the recipient is not listed as an employee of Plaintiff corporation.
0108	Attorney-Client	11/20/1986	Memorandum with attachment	Privileged
0109	Attorney-Client	12/31/1985	Form with attachment	Privileged
0110	Attorney-Client	12/31/1985	Correspondence	Privileged
0111	Attorney-Client	11/20/1984	Form	Privileged
0112	Attorney-Client	09/29/1986	File History	Privileged
0114	Attorney-Client	01/09/1988	Correspondence	Privileged
0117	Attorney-Client	05/12/1988	File History	Privileged
0128	Attorney-Client	11/09/1989	Report	Not Privileged-Produce
0129	Attorney-Client	01/02/1990	Report	Not Privileged-Produce

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0130	Attorney-Client	02/1990	Report	Privileged
0132	Attorney-Client	05/11/1990	Correspondence	Not Privileged-Produce. The party asserting the privilege has the burden of proving its applicability. Plaintiff asserts that the redacted portion is advice from outside counsel Warren Woessner, however, this is not evidenced in the document and therefore Plaintiff has failed to meet their burden. Plaintiff must either provide the Court with further evidence in support of Woessner's involvement, or produce the document.
0134	Attorney-Client	10/03/1990	Report	Privileged
0135	Attorney-Client	11/05/1990	Correspondence with attached reports	Privileged
0136	Attorney-Client	02/15/1991	Correspondence with attached reports	Privileged
0137	Attorney-Client	11/17/1989	Correspondence with attached reports	Privileged
0143	Attorney-Client/ Work Product	No Date	File Folder Cover	Privileged (Attorney-Client)
0144	Attorney-Client	12/31/1985	Form with attachment	Privileged
0145	Attorney-Client	11/20/1984	Form	Privileged
0146	Attorney-Client	12/31/1985	Correspondence with attachment	Privileged
0147	Attorney-Client	12/31/1985	Correspondence with attachment	Privileged



<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0148	Attorney-Client	12/31/1985	Form with attachment	Privileged
0149	Attorney-Client/ Work Product	2/13/2002- 02/19/2002	E-mail chain	Privileged
0150	Attorney-Client	11/20/1984	Form	Privileged
0151	Attorney-Client/ Work Product	2/15/2002- 3/07/2002	E-mail chain	Privileged
0152	Attorney-Client/ Work Product	2/13/2002- 2/19/2002	E-mail chain	Privileged
0153	Attorney-Client	04/18/1989	Form with attachments	Privileged
0156	Attorney-Client	No Date	Draft Patent Drawings	Not Privileged-Produce. There is no evidence that this document was produced for or by attorney Dennis Hoerner, and no attorney is listed by Plaintiff as creating or receiving the document. Unless Plaintiff can provide further evidence regarding how this document is protected by the Attorney-Client privilege, it must be produced.
0157	Attorney-Client	03/05/1991	Report	Privileged
0158	Attorney-Client	04/29/1991	Correspondence with attached reports	Privileged
0159	Attorney-Client	04/29/1991	Correspondence with attached reports	This appears to be a duplicate of No. 0158. Plaintiff shall explain why duplicates are submitted.
0160	Attorney-Client	06/02/1991	Correspondence with attached reports	Privileged

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0161	Attorney-Client	11/14/1991	Correspondence with attached reports	Not Privileged-Produce. Plaintiff states in its privilege log that this report was located in Monsanto or Dekalb's legal files, and that the redacted portion is legal advice from Warner Woessner. There is no evidence in the document that this was advice from Woessner, and he is neither the recipient nor the author. Plaintiff shall produce the documents, unless they can provide further evidence that the redacted portion is legal advice.
0163	Attorney-Client	08/08/1990	Correspondence with attached reports, contained within "Field Stations 2nd Qtr. Reports" file folder	Privileged
0164	Attorney-Client	10/1990	Reports	Privileged
0166	Attorney-Client	05/22/1992	Report	Privileged
0172	Attorney-Client	07/11/1988	Report	Privileged
0174	Attorney-Client	07/18/1990	Report with hand written notes	Privileged

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0175	Attorney-Client	1990	Report	Not Privileged-Produce. Plaintiff states in its privilege log that this report was located in Monsanto or Dekalb's legal files, and that the redacted portion is legal advice from Warner Woessner. There is no evidence in the document that this was advice from Woessner, and he is neither the author nor the recipient. Plaintiff shall produce the document, unless they can provide further evidence that the redacted portion is legal advice.
0177	Attorney-Client	12/04/2004	E-mail chain of correspondence	Privileged
0178	Attorney-Client/ Work Product	2003	Presentation	Privileged (Attorney-Client and Work Product)
0182	Work Product	2004	Draft Correspondence	Privileged
0193	Attorney-Client	04/05/2005	Publication and hand written notes	The hand written notes are privileged. However, the remainder of the document is not privileged as it does not reflect legal advice or communication with an attorney and therefore must be produced.
0196	Attorney-Client	05/05/1988	Report	Privileged
0198	Attorney-Client	07/1988	Report	Privileged
0200	Attorney-Client	02/19/1988	Report	Privileged
0201	Attorney-Client	03/25/1988	Report	Privileged
0202	Attorney-Client	04/22/1988	Report	Privileged

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0203	Attorney-Client	07/15/1988	Report	<p>The redacted portions on page one under the heading 1. Lysine, are not privileged. Plaintiff must either produce this information or provide the court with further evidence of an attorney's involvement.</p> <p>The redacted portion on page six is Privileged under the Work Product Doctrine.</p>
0204	Attorney-Client	07/15/1988	Report	Privileged
0205	Attorney-Client	1992	Report	<p>Not Privileged-Produce. Plaintiff states in its privilege log that this report was located in Monsanto or Dekalb's legal files, and that the redacted portion is legal advice from Warner Woessner. There is no evidence in the document that this was advice from Woessner, and he is neither the author nor the recipient. Plaintiff shall produce the document, unless they can provide further evidence that the redacted portion is legal advice.</p>
0207	Attorney-Client	No Date	Report/Outline	Privileged
0220	Attorney-Client	06/27/1996	Correspondence with attachments	Privileged
0221	Attorney-Client	01/12/1990	Correspondence	Privileged
0222	Attorney-Client	01/12/1990	Correspondence	Privileged
0223	Attorney-Client	12/13/1989	Correspondence	Privileged

<b>Priv. Doc. No.</b>	<b>Privilege Asserted</b>	<b>Date</b>	<b>Document Type</b>	<b>Court's Ruling</b>
0224	Attorney-Client/ Work Product	08/23/2000	Report	Privileged-Attorney-Client
0225	Attorney-Client	03/27/1990	Correspondence	Privileged
0226	Attorney-Client	2/14/1990- 2/15/1990	Correspondence	Privileged
0227	Attorney-Client	02/12/1990	Correspondence	Privileged
0228	Attorney-Client	03/07/1990	Handwritten Notes	Privileged
0230	Attorney-Client	06/29/1988	Correspondence	Privileged
0232	Attorney-Client	01/15/1990	Handwritten notes	Privileged
0233	Attorney-Client	01/15/1990	Draft Patent Addendum	Not Privileged-Produce. Plaintiff is to provide the Court with additional explanation as to how they identified Jacobs as the author of this document, otherwise they must produce it.
0234	Attorney-Client	01/19/1990	Notes	Not-Privileged Produce. Plaintiff is to provide the Court with additional explanation as to how they identified Jacobs as the author of this document, otherwise they must produce it.
0235	Attorney-Client	05/19/1990	Lab Notebooks with attached correspondence	The last page of this document is privileged. However, there are a number of black squares on pages 48- 49. The Court believes that these are illustrations of Western Blots. However, if they are not, Plaintiff shall provide further explanation as to why they are redacted.

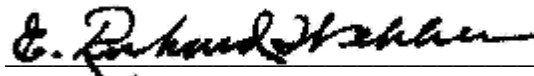
Priv. Doc. No.	Privilege Asserted	Date	Document Type	Court's Ruling
0236	Attorney-Client	01/20/2001	Handwritten Notes	Privileged
0237	Attorney-Client	05/13/1996	Correspondence with attachments	Privileged
0238	Attorney-Client	05/09/1996	Correspondence	Privileged
0239	Attorney-Client/ Work Product	05/08/1996	Correspondence	Privileged (Attorney-Client)
0241	Attorney-Client	09/19/2001	Correspondence	Privileged
0242	Attorney-Client	01/14/2000	Correspondence	Privileged
0243	Attorney-Client	09/05/2001	Correspondence	Privileged
0244	Attorney-Client	04/17/2001	Correspondence	Privileged
0245	Attorney-Client	02/23/1999	Correspondence	Privileged
0246	Attorney-Client	02/22/2000	Correspondence	Not Privileged-Produce. This document does not show that any connection to Dennis Hoerner. Plaintiff shall either provide additional evidence of Hoerner's involvement, or produce the document.
0247	Attorney-Client	02/01/1994	Notes with attachment	Privileged

Accordingly,

**IT IS HEREBY ORDERED** that Defendant's Motion to Compel Production of Documents [doc. #63] is **GRANTED in part and DENIED in part**. Plaintiff shall produce documents in accordance with this order.

**IT IS FURTHER ORDERED** that Plaintiff has ten (10) days from the date of this order to provide the Court with further explanation on those documents specified above, or in the alternative to produce the documents.

Dated this 9th Day of July, 2007.

A handwritten signature in black ink, appearing to read "E. Richard Webber", written over a horizontal line.

E. RICHARD WEBBER  
UNITED STATES DISTRICT JUDGE